

Appl. No. 10/676,058
Amdt. dated 03/27/2006
Reply to Office action of 03/06/2006

REMARKS/ARGUMENTS

Reconsideration is requested of all rejections based on 35 U.S.C. 102:

Examiner's argument with respect to taking as broad a view as possible of the term 'continuous' is understood. We have, accordingly, amended claims 15, 16, 19, and 22 to reflect the fact that the parts making up the structures claimed by the present invention cannot be separated from one another without damaging one or both of said parts (this being an inherent characteristic of a body formed through sintering).

In contrast, both Wentorf Jr. and Engelfriet's structures teach bodies whose component parts can be separated by non-destructive means:

In Wentorf's structure there is a layer of cement between the various parts that make up the claimed structure. Thus, the application of a suitable solvent will, given sufficient time, enable this structure to be disassembled without damaging either part..

Engelfriet's structure is formed by press fitting. There is thus a film of air between the various parts that make up the claimed structure. Such a structure can be non-destructively disassembled through the application of forces opposite to those used during assembly.

Reconsideration is requested of all rejections based on the judicially created doctrine of obviousness-type double patenting :

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With respect to claims 15-24, rejected as being unpatentable over claims 11-26 of US 6,461,563:

Examiner has sustained this rejection on the grounds that "the inherent characteristics of the different materials meet the claim limitations." We note, however, that the MPEP section 2112 states, in part:

"EXAMINER MUST PROVIDE RATIONALE OR EVIDENCE TENDING TO SHOW INHERENCY

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); In re Oelrich, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). "To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities..... In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art."

In our previous response to this particular rejection we pointed out that not all functional properties are necessarily fully compatible with one another. Thus it is clear (from the section of the MPEP quoted above) that, to sustain his rejection, Examiner

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must provide evidence that selecting the particular combinations of functional properties that the present invention teaches to be mutually compatible, would be obvious to one skilled in the art without the need for prior experimentation.

One skilled in the art, applying the teachings of the present invention to 6,461,563, will, in general, have a greater likelihood of immediate success than one limited to the practice of 6,461,563 alone. Prior to launching our investigation, it was by no means obvious which pairs of functional properties would turn out to be the best.

Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

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